



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,129	02/09/2001	Wilson Zehr	51001-P003X	1696

25943 7590 06/17/2004

SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITES 1600-1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT	PAPER NUMBER
----------	--------------

2157

DATE MAILED: 06/17/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,129

Applicant(s)

ZEHR ET AL.

Examiner

Salad E Abdullahi

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-40 are pending. The rejection cited stated below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1,4-12,15-18, 20, 21, 24-32,35-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ukita et al., U.S. Patent No. 6,622,174[hereinafter Ukita] in view of Namias U.S. Patent publication No. 2002/0112005[hereinafter Namias] As to claim 1, Ukita discloses method comprising:
receiving an indication to send a message to a plurality of recipients (see col. 4, line 45 to col. 5, line 14);

determining if an insertion of an advertisement of a selected one of a link to an advertisement of an advertiser and the advertisement itself, the advertisement having a monetary value associated with it, is received (see col. 25, lines 13-35); and automatically reducing the monetary cost associated with sending the message by the monetary value of the inserted advertisement, upon determining that the insertion is received (see col. 35, lines 22-29).

Ukita is silent regarding: automatically determining a monetary cost associated with sending the message.

Namias discloses a method for creating a message intended for plurality of recipients including the step of automatically determining a monetary cost associated with sending the message (see fig. 6 and page 3, column 2, paragraph 0041). Furthermore, Ukita describes various types of data communication services such as electronic mail, and facsimile and providing them with minimal cost. Hence, one skilled in the art would readily recognized the advantage of automatically determining a monetary cost associated with sending such communication services as taught by Namias to enable the users of the data communication services to determine the cost of such services a head of time so they can accept the service or reject. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Namias such automatically determining a monetary cost associated with sending a message into Ukita's system in order to provide a user the cost of transmitting messages a head of time, thus enabling the user whether to accept the cost or not.

As to claim 4, Ukita discloses the method of claim 1, wherein said receiving the indication comprises receiving a group selection (see col. 17, lines 19-33).

As to claim 5, Namias discloses the method of claim 1, wherein said automatically determining the monetary cost comprises automatically determining a monetary cost based at least in part on a number of the plurality of recipients (i.e., plurality of members) (see fig. 6 and page 3, column 2, paragraph 0041).

As to claim 6, Namias discloses the method of claim 1, wherein said automatically determining comprises automatically generating and displaying the monetary cost associated with sending the message to the plurality of recipients (see fig. 6 and page 3, column 2, paragraph 0041).

As to claim 7, Namias discloses the method of claim 6, wherein said automatically generating comprises automatically generating an updateable window displaying the monetary cost (see fig. 6, price display window 620 and page 3, paragraph 0041).

As to claim 8, Ukita discloses the method of claim 1, wherein said receiving the insertion comprises automatically generating and displaying a selectable menu of a category of advertisers, the category based at least in part on attributes associated with the plurality of recipients (see col. 17, lines 19-25 and col. 35, lines 22-29).

As to claim 9, Ukita discloses the method of claim 1, wherein said receiving the insertion comprises receiving an insertion of a selected one of a link to an advertisement of an advertiser and the advertisement itself (see col. 19, lines 6-34).

As to claim 10, Ukita discloses the method of claim 1, wherein said receiving the insertion comprises receiving an inputted category of an advertiser (see col. 17, lines 19-25).

As to claim 11, Ukita discloses the method of claim 1, wherein said automatically reducing the monetary cost comprises automatically reducing the monetary costs by a monetary value of one or more inserted advertisements (see col. 11, lines 5-14 and col. 35, lines 22-29).

As to claim 12, Ukita discloses in a client device, a method comprising:
facilitating sending a message to a plurality of recipients (i.e., targeted users) included within a group (i.e., members) (see col. 4, line 45 to col. 5, line 14);
facilitating insertion of a selected one of a link to an advertisement of an advertiser and the advertisement itself, in the message prepared by a sender, the advertisement having a monetary value associated with it (see col. 25, lines 13-35); and
facilitating updating of the monetary cost associated with sending the message (see col. 35, lines 22-29).

Ukita is silent regarding: facilitating receiving a monetary cost associated with sending the message.

Namias discloses a method for creating a message intended for plurality of recipients including the step of automatically determining a monetary cost associated with sending the message (see fig. 6 and page 3, column 2, paragraph 0041). Furthermore, Ukita describes various types of data communication services such as electronic mail, and facsimile and providing them with minimal cost. Hence, one skilled in the art would readily recognized the advantage of facilitating receiving a monetary cost associated with sending such communication services as taught by Namias to enable the users of the data communication services to determine the cost of such services a head of time so they can accept the service or reject. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Namias such as facilitating receiving a monetary cost associated with sending a message into Ukita's system in order to provide a user the cost of transmitting messages a head of time, thus enabling the user whether to accept the cost or not.

As to claim 15; Ukita discloses the method of claim 12, wherein said sending facilitation comprises facilitating selection of a single group, the group including the plurality of recipients (see col. 17, lines 19-25).

As to claim 16, Ukita discloses the method of claim 12, wherein said sending facilitation

comprises facilitation of automatic generation and displaying an e-mail messaging window (see col. 1, lines 59-64).

As to claim 17, Namias discloses the method of claim 12, wherein said receiving facilitation comprises facilitating automatic generation and displaying of the received monetary cost included within a cost window (see fig. 6, price display window 620 and page 3, paragraph 0041).

As to claim 18, Ukita discloses the method of claim 12, wherein said insertion facilitation comprises facilitating automatic arrangement of the link to the advertisement/the advertisement itself (see col. 19, lines 6-34).

As to claim 20, Ukita discloses the method of claim 12, wherein said updating facilitation comprises facilitating receiving a reduced monetary cost, the received reduced monetary cost based at least in part on the value of the inserted link to the advertisement/the advertisement itself (see col. 11, lines 5-14).

As to claim 21, Ukita discloses an apparatus (see fig. 6) comprising:
a storage medium having stored therein a plurality of programming instructions designed to receive an indication to send a message to a plurality of recipients (see col. 4, line 45 to col. 5, line 14), determine if an insertion of an advertisement of a selected one of a link to an advertisement of an advertiser and the advertisement itself, the

advertisement having a monetary value associated with it, is received (see col. 25, lines 13-35), and automatically reduce the monetary cost associated with sending the message by the value of the inserted link to the advertisement/the advertisement itself, upon determining that the insertion is received(see col. 25, lines 13-35); and a processor coupled to the storage medium to execute the programming instructions (see fig. 6, and col. 12, lines 58-67).

Ukita is silent regarding: automatically determining a monetary cost associated with sending the message.

Namias discloses a method for creating a message intended for plurality of recipients including the step of automatically determining a monetary cost associated with sending the message (see fig. 6 and page 3, column 2, paragraph 0041). Furthermore, Ukita describes various types of data communication services such as electronic mail, and facsimile and providing them with minimal cost. Hence, one skilled in the art would readily recognized the advantage of automatically determining a monetary cost associated with sending such communication services as taught by Namias to enable the users of the data communication services to determine the cost of such services a head of time so they can accept the service or reject. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Namias such automatically determining a monetary cost associated with sending a message into Ukita's system in order to provide a user the cost of transmitting messages a head of time, thus enabling the user whether to accept the cost or not.

Art Unit: 2157

As to claim 24, Ukita discloses the apparatus of claim 21, wherein the programming instructions are designed to receive a group selection (see col. 17, lines 19-33).

As to claim 25, Namias discloses the apparatus of claim 21, wherein the programming instructions are designed to automatically determine a monetary cost based at least in part on a number of the plurality of recipients (see fig. 6, price display window 620 and page 3, paragraph 0041).

As to claim 26, Namias discloses the apparatus of claim 21, wherein the programming instructions are designed to automatically generate and display the monetary cost associated with sending the message to the plurality of recipients (see fig. 6, price display window 620 and page 3, paragraph 0041).

As to claim 27, Namias discloses the apparatus of claim 26, wherein the programming instructions are designed to automatically generate an updateable window displaying the monetary cost (see fig. 6, price display window 620 and page 3, paragraph 0041).

As to claim 28, Ukita discloses the apparatus of claim 21, wherein the programming instructions are designed to automatically generate and display a selectable menu of a category of advertisers, the category based at least in part on attributes associated with the plurality of recipients (see col. 17, lines 19-25 and col. 35, lines 22-29).

As to claim 29, Ukita discloses the apparatus of claim 21, wherein the programming instructions are designed to receive an insertion of a selected one of a link to an advertisement of an advertiser and the advertisement itself (see col. 11, lines 5-14).

As to claim 30, Ukita discloses the apparatus of claim 21, wherein the programming instructions are designed to receive an inputted category of an advertiser (see col. 17, lines 19-33).

As to claim 31, Ukita discloses the apparatus of claim 21, wherein the programming instructions are designed to automatically reduce the monetary costs by a monetary value of one or more inserted advertisements (see col. 11, lines 5-14 and col. 35, lines 22-29).

As to claim 32, Ukita discloses an apparatus comprising: a storage medium having stored therein a plurality of programming instructions designed to facilitate sending a message to a plurality of recipients included within a group (see col. 4, line 45 to col. 5, line 14), facilitate insertion of a selected one of a link to an advertisement of an advertiser and the advertisement itself, in the message prepared by a sender(see col. 11, lines 5-14), the advertisement having a monetary value associated with it (see col. 11, lines 5-14), and facilitate updating of the monetary cost associated with sending the message; and a processor coupled to the storage medium to execute the programming instructions(see fig. 6, and col. 12, lines 58-67).

Ukita is silent regarding: facilitate receiving a monetary cost associated with sending the message.

Namias discloses a method for creating a message intended for plurality of recipients including the step of automatically determining a monetary cost associated with sending the message (see fig. 6 and page 3, column 2, paragraph 0041). Furthermore, Ukita describes various types of data communication services such as electronic mail, and facsimile and providing them with minimal cost. Hence, one skilled in the art would readily recognized the advantage of facilitate receiving a monetary cost associated with sending such communication services as taught by Namias to enable the users of the data communication services to determine the cost of such services a head of time so they can accept the service or reject. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Namias such automatically determining a monetary cost associated with sending a message into Ukita's system in order to provide a user the cost of transmitting messages a head of time, thus enabling the user whether to accept the cost or not.

As to claim 35, Ukita discloses 35 the apparatus of claim 32, wherein the programming instructions are designed to facilitate selection of a single group, the group including the plurality of recipients (see col. 17, lines 19-33).

As to claim 36, Ukita discloses 36 the apparatus of claim 32, wherein the programming

instructions are designed to facilitate automatic generation and displaying an e-mail messaging window (see col. 1, lines 59-64).

As to claim 37, Namias discloses the apparatus of claim 32, wherein the programming instruction are designed to facilitate automatic generation and displaying of the received monetary cost included within a cost window (see fig. 6, price display window 620 and page 3, paragraph 0041).

As to claim 38, Ukita discloses the apparatus of claim 32, wherein the programming instructions are designed to facilitate automatic arrangement of the link to the advertisement/the advertisement itself (see col. 11, lines 5-14 and col. 19, lines 6-34).

As to claim 40, Ukita discloses the apparatus of claim 32, wherein the programming instructions are designed to facilitate receiving a reduced monetary cost, the received monetary cost based at least upon the value of the inserted link to the advertisement/the advertisement itself (see col. 11, lines 5-14 and col. 19, lines 6-34).

3. Claims 2-3, 13-14, 22-23, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable Ukita and Namias and further in view of Heiden U.S. Patent No. 6,408,286 [hereinafter Heiden].

As to claim 2, Ukita and Namias discloses substantial features of the claimed invention

as discussed above with respect to claim 1, including attaching advertisement to a messages.

Ukita and Namias are silent regarding:

automatically attaching one or more coupons to the message, based at least upon the inserted advertisement.

Heiden in analogous art discloses system for distributing digital coupons in including the step of automatically attaching one or more coupons to the message, based at least upon the inserted advertisement (see col. 3, lines 48-67 and col. 5, lines 35-51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Heiden such as automatically attaching one or more coupons to the message, based at least upon the inserted advertisement into the system of Ukita and Namias because the advantage of attaching one or more coupons to the message, is to provide users with incentive to buy more products.

As to claim 3, Heiden discloses the method of claim 2, wherein the attached one or more coupons is at least one of an electronic coupon and a printable coupon (see col. 3, lines 48-67 and col. 5, lines 35-51).

As to claim 13, Ukita and Namias discloses substantial features of the claimed invention as discussed above with respect to claim 12, including attaching advertisement to a messages.

Ukita and Namias are silent regarding:

automatically attaching one or more coupons to the message, based at least upon the inserted advertisement.

Heiden in analogous art discloses system for distributing digital coupons in including the step of automatically attaching one or more coupons to the message, based at least upon the inserted advertisement (see col. 3, lines 48-67 and col. 5, lines 35-51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Heiden such as automatically attaching one or more coupons to the message, based at least upon the inserted advertisement into the system of Ukita and Namias because the advantage of attaching one or more coupons to the message, is to provide users with incentive to buy more products.

As to claim 14, Heiden discloses the method of claim 12, wherein the attached one or more coupons is at least one of an electronic coupon and a printable coupon (see col. 3, lines 48-67 and col. 5, lines 35-51).

As to claim 22, Ukita and Namias discloses substantial features of the claimed invention as discussed above with respect to claim 21, including attaching advertisement to a messages.

Ukita and Namias are silent regarding:

automatically attaching one or more coupons to the message, based at least upon the inserted advertisement.

Heiden in analogous art discloses system for distributing digital coupons in including the step of automatically attaching one or more coupons to the message, based at least upon the inserted advertisement (see col. 3, lines 48-67 and col. 5, lines 35-51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Heiden such as automatically attaching one or more coupons to the message, based at least upon the inserted advertisement into the system of Ukita and Namias because the advantage of attaching one or more coupons to the message, is to provide users with incentive to buy more products.

As to claim 23, Heiden discloses the method of claim 22, wherein the attached one or more coupons is at least one of an electronic coupon and a printable coupon (see col. 3, lines 48-67 and col. 5, lines 35-51).

As to claim 33, Ukita and Namias discloses substantial features of the claimed invention as discussed above with respect to claim 21, including attaching advertisement to a messages.

Ukita and Namias are silent regarding:

automatically attaching one or more coupons to the message, based at least upon the inserted advertisement.

Heiden in analogous art discloses system for distributing digital coupons in including the step of automatically attaching one or more coupons to the message, based at least upon the inserted advertisement (see col. 3, lines 48-67 and col. 5, lines 35-51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Heiden such as automatically attaching one or more coupons to the message, based at least upon the inserted advertisement into the system of Ukita and Namias because the advantage of attaching one or more coupons to the message, is to provide users with incentive to buy more products.

As to claim 34, Heiden discloses the method of claim 33, wherein the attached one or more coupons is at least one of an electronic coupon and a printable coupon (see col. 3, lines 48-67 and col. 5, lines 35-51).

4. Claims 19 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable Ukita and Namias and further in view of Krishan et al., U.S. Patent No. 6,442,529[hereinafter Krishan].

As to claim 19, Ukita and Namias disclose substantial features of the claimed invention as discussed above with respect to claim 18 including automatic facilitating receiving a monetary cost associated with sending the message.

Ukita and Namias is silent regarding:

wherein said automatic arrangement facilitation comprises facilitating receiving an associated price for a position and size on a message page, the arrangement based at least in part on the price.

Krishan in an analogous art discloses a method and a system for targeting information to plurality of recipients including facilitating receiving an associated price for a position

and size on a message page, the arrangement based at least in part on the price (see col. 7, lines 17-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Krishan into the system of Ukita and Namias such that messages can be displayed according to the preferences of a user, hence enabling charges to be applied per user preference basis.

As to claim 39, Ukita and Namias disclose substantial features of the claimed invention as discussed above with respect to claim 38 including programming instructions that facilitate receiving a monetary cost associated with sending the message.

Ukita and Namias is silent regarding:

wherein the programming instructions are designed to facilitate receiving an associated price for a position and size on a message page, the arrangement based at least in part on the price.

Krishan in an analogous art discloses a method and a system for targeting information to plurality of recipients including programming instructions designed to facilitate receiving an associated price for a position and size on a message page, the arrangement based at least in part on the price (see col. 7, lines 17-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the teaching of Krishan into the system of Ukita and Namias such that messages can be displayed according to the preferences of a user, hence enabling charges to be applied per user preference basis.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 703-308-8441. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to: (703) (872-9306).



Abdullahi Salad

Examiner AU 2157

6/10/2004